

REMARKS

Claims 25-34 are pending in the application.

Claims 1-24 had been earlier cancelled without prejudice.

Claims 29, 30, and 31 have been amended to correct minor informalities.

Claims 32-34 have been amended to more clearly define that which Applicant claims as its invention.

No new matter has been added.

Reconsideration of the Claims is respectfully requested.

1. Claim Rejections under 35 U.S.C. § 103(a)

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142, p. 2100-128 (Rev. 2, May 2004) (citations omitted).

a. Claims 25 and 27 were rejected under 35 USC § 103(a) as being unpatentable over US Patent No. 6,393,272 ("Cannon") in view of US Patent No. 6,633,634 ("Crockett") and US Patent No. 6,665,375 ("Forlenza"). Applicant respectfully traverses this rejection.

Cannon recites a system "minimize the inconvenience to an incoming caller, while also minimizing the disruptive effect that an incoming call has on an on-going meeting.." (Cannon 1:35-38). The Cannon telephone has a "controller 109 [that] will respond to a signal from Answer & Hold input element 121 of input unit 107 to answer an incoming call, cause the outgoing message unit 119 to output a particular outgoing message, and maintain a connection status of the incoming call." (Cannon 2:22-27).

Crockett recites a caller ID "system 10 [that] enables a customer at the called communication station 30, who is busy on a previous call, to be efficiently and effectively notified that a current call from calling communication station 40 is waiting. The system 10

provides an enhanced call waiting message that includes both the call waiting indicator and the audible representation of information associated with the calling communication station 40.” (Crockett 2:51-58). That is, Crockett is a call waiting system, which “generally notif[ies] a customer that is busy on a previous call that a current call has been placed to the customer,” (Crockett 1:14-17), but does not place an incoming call on hold, or maintain the call.

Forlenza recites a “telephone with a customized display for displaying call connection status information . . . such as ringing and busy signals, and presents the call status via a status indicator.” (Forlenza 1:42-47). Through Forlenza was cited for a voice response systems, such systems being “an automated telephone answering system that responds with a voice menu and allows the user to make choices and enter information via the keypad or spoken input. IVR systems are widely used in call centers as well as a replacement for human switchboard operators.” (Forlenza 3:32-16). Forlenza does not discuss placing incoming calls on hold.

Applicant respectfully submits that there is no suggestion or motivation in the cited references to modify or combine the caller-on-hold device of Cannon, with the call waiting device of Crockett, with the IVR device of Forlenza to achieve Applicant’s claimed invention. The Office Action noted that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device” of Applicant’s Claims 25 and 27. (Office Action at p. 3). Presuming this statement was made based on “common knowledge,” no support was provided, and it is submitted that such circumstances should be rare when an application is, such as here, under final rejection. MPEP 2144.03 at p. 2100-136.

For example, Applicant’s independent Claim 25 recites, *inter alia*, a “mobile station, comprising: communication circuitry for processing wireless communication signals; audio processing circuitry for converting between sound and audio signal and for receiving sound from a microphone and for producing sound to a speaker; logic to prompt the mobile station to generate signaling to a communication network element to complete call setup including completing connection of a voice channel and further to mute the microphone even though the voice channel is connected; logic to prompt the mobile station to prompt a called party to take the call after a specified period of time as a reminder that a calling party is on hold”

In this regard, Applicant respectfully submits that a *prima facie* case of obviousness has not been made, and requests that the rejection to its Claim 25, and Claim 27 that depends therefrom, be withdrawn.

b. Claim 26 was rejected under 35 USC § 103(a) as being unpatentable over Cannon in view of Crockett, Forlenza, and US Patent No. 6,606,505 (“Chow”). Applicant respectfully traverses this rejection.

Chow recites a “wireless centrix system (WCS) that allows a subscriber to use the same standard cellular/PCS telephone in both the wireless centrix system domain as well as the public cellular system domain. In the WCS domain, subscribers can use their cellular PCS as a cordless-like phone without incurring air-time charges. The WCS has the advantage of providing a working environment mobile telephone system having traditional centrex and PBX type services such as call waiting, call hold, call forwarding, caller ID, three party conference calling, and call messaging.” (Chow 2:29-38).

Claim 26 depends from Claim 25. In that the combination of Cannon in view of Crockett and Forlenza does not provide a *prima facie* showing of obviousness with respect to Claim 25, Applicant respectfully submits that the addition of Chow to the hypothetical combination similarly does not establish a *prima facie* case of obviousness. Applicant respectfully requests that the rejection to its Claim 26 be withdrawn.

c. Claims 28-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cannon in view of Crockett.

Applicant respectfully submits that there is no suggestion or motivation in the cited references to modify or combine the caller-on-hold device of Cannon, with the call waiting device of Crockett. As noted, Crockett provides caller ID “efficiently and effectively” to notify a customer, who is busy on a previous call at a called communication station, that there is a current call waiting. (Crockett 1:14-17). That is, Crockett does not place a “current call waiting” on hold or maintain that call.

In contrast, Applicants Independent Claim 28 recites, *inter alia*, a “mobile station, comprising: . . . audio processing circuitry for converting between sound and audio signal and for receiving sound from a microphone and for producing sound to a speaker; logic to prompt the mobile station to prompt a called party to take the call after a specified period of time has elapsed as a reminder that a calling party is on hold; and logic circuitry for prompting the mobile station to complete call connection including the voice channel and further to mute the microphone until the called party takes the call to prevent audio transmission over the voice channel until the called party takes the call”

In this regard, Applicant respectfully submits that a *prima facie* case of obviousness has not been made, and requests that the rejection to its Claim 28, and Claims 28-31 that depend directly or indirectly therefrom, be withdrawn.

d. Claims 32-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chow in view of Forlenza. Applicant respectfully traverses this rejection.

Claims 32 and 33 have been amended. In this regard, Applicant respectfully submits that the rejection of Chow in view of Forlenza would not apply, and requests that the rejection be withdrawn to these claims.

e. Claim 34 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Chow in view of Forlenza and Crockett. Applicant respectfully traverses this rejection.

Claim 32 and dependent Claim 34 have been amended. Claims 32 and 33 have been amended. In this regard, Applicant respectfully submits that the rejection of Chow in view of Forlenza would not apply, and requests that the rejection be withdrawn to these claims.

2. Conclusion

As a result of the foregoing, the Applicant asserts that Claims 25-34 are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ksmith@texaspatents.com.

The Commissioner is authorized to charge any additional fees connected with this communication and/or credit any overpayment to Garlick Harrison & Markison Deposit Account No. 50-2126 (11271STUS01U).

Respectfully submitted,

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